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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,609	01/23/2001	Takehiro Yoshida	35.G2716	1886
5514	7590	06/02/2005	EXAMINER PARK, CHAN S	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			ART UNIT	PAPER NUMBER

2622

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/766,609

Applicant(s)

YOSHIDA, TAKEHIRO

Examiner

CHAN S. PARK

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment was received on 3/17/05, and has been entered and made of record. Currently, **claims 2-6** are pending.

### ***Specification***

2. The corrected or substitute specification was received on 3/17/05. The specification is acceptable.

### ***Allowable Subject Matter***

3. The indicated allowability of claim 4 is withdrawn in view of the newly discovered references to Endo U.S. Patent No. 6,449,062 and Yoshida Japanese Patent Publication No. 10-304166. Rejections based on the newly cited references follow.

### ***Drawings***

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitation of displaying a message if a communication error occurs after the transmission of a SUB/DCS signal must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended

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replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Endo in view of Yoshida Japanese Patent Publication No. 10-304166.

5. With respect to claim 4, Endo discloses an image communication apparatus transmitting a subaddress signal, the apparatus comprising:

extension number input means for inputting a plurality of extension numbers as information of the subaddress signal (col. 3, lines 36-40);

secondary telephone number input means for inputting a plurality of secondary telephone numbers (col. 4, lines 19-27);

direct input means for directly inputting particular information (fig. 1); and

display means for displaying an acknowledge message when the particular information is input from the direct input means (col. 5, lines 15-20),

wherein the subaddress signal, with the plurality of the extension numbers designated by the extension number input means for inputting the plurality of the extension numbers (fig. 1), or the plurality of the secondary telephone numbers designated by the secondary telephone number input means for inputting the plurality of the secondary telephone numbers, or both the extension number and the secondary telephone number designated by the direct input means for directly inputting the particular information, is transmitted (fig. 4).

Endo, however, does not disclose expressly that a message is displayed if a communication error occurs after the transmission of a SUB/DCS signal.

Yoshida, the same field of endeavor of the facsimile art, discloses that a message is displayed if a communication error occurs after the transmission of a SUB/DCS signal (paragraphs 39-41, 46-49 & 56). Also, refer to col. 18, lines 56-61 of U.S. Patent No. 6,281,987 for another translation.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate the method for displaying a message when a communication error occurs of Yoshida into the facsimile of Endo.

The suggestion/motivation for doing so would have been to properly notify the user of by displaying an appropriate message.

Therefore, it would have been obvious to combine Endo with Yoshida to obtain the invention as specified in claim 4.

6. With respect to claim 5, Endo discloses the image communication apparatus according to claim 4, wherein the displayed message prompts a user to check to see whether the partner apparatus has one of the function of receiving the plurality of the extension numbers, the function of receiving the plurality of the secondary telephone numbers, and the function of receiving both the extension number and the secondary telephone number (col. 5, line 61 – col. 6, line 8). Further, Yoshida discloses the image communication apparatus wherein the capability of the receiving part is checked before carrying out the image data transmission (paragraphs 39-41, 46-49 & 56).

7. With respect to claim 6, Endo discloses the image communication apparatus according to claim 4, wherein the image communication apparatus is a facsimile apparatus (fig. 1).

8. With respect to claim 2, Endo discloses the image communication apparatus according to claim 4, wherein the particular information input by the direct input means is one of symbols # and ##, and

wherein when the input of a plurality of pieces of numerical information delimited by one of the symbols # and ## is selected (col. 5, lines 4-12), a message is displayed to prompt a user to acknowledge the designation of a plurality of extension numbers, the designation of a plurality of secondary telephone numbers, or the designation of an extension number and a secondary telephone number (col. 5, lines 15-20).

9. With respect to claim 3, Examiner takes Official Notice that changing the displayed message in response to directly input information is well known in the facsimile art. For example, when a user mistakenly enters a wrong telephone number, a conventional facsimile machine has a function for correcting the number and displaying the corrected number in the display. Thus, it would have been obvious at the time of the invention was made to one of ordinary skill in the art to display the changed message in response to the information of the directly input subaddress since Examiner take Official Notice that changing the displayed message in response to directly input information is well known in the facsimile art.

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571) 272-7409. The examiner can normally be reached on M-F 8am-4:30pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chan S. Park  
Examiner  
Art Unit 2622

csp  
May 19, 2005

  
EDWARD COLES  
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